REMARKS

Claims 1-39 remain in the application for consideration. In view of the following remarks, Applicant respectfully requests that this application be allowed and forwarded on to issuance.

The § 103 Rejections

Claims 1-39 stand rejected under 35 U.S.C. § 103(a) as being obvious over by U.S. Patent No. 6,421,733 to Tso et al. (hereinafter "Tso").

Applicant respectfully submits that the Office has not established a *prima facie* case of obviousness. Accordingly, Applicant respectfully submits that its claims are allowable.

The § 103 Standard

To establish a prima facie case of obviousness, three basic criteria *must* be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992); *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988). Second, there must be a reasonable expectation of success. *In re Merck & Co., Inc.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974).

Hence, when patentability turns on the question of obviousness, the search for and analysis of the prior art includes evidence relevant to the finding of whether there is a teaching, motivation, or suggestion to select and combine the references relied on as evidence of obviousness. See, e.g., *McGinley v. Franklin Sports, Inc.*, 262 F.3d 1339, 1351-52, 60 USPQ2d 1001, 1008 (Fed. Cir. 2001) ("the central question is whether there is reason to combine [the] references," a question of fact drawing on the Graham factors).

"The factual inquiry whether to combine references must be thorough and searching." *Id.* It must be based on objective evidence of record. This precedent has been reinforced in myriad decisions, and cannot be dispensed with. See, e.g., *Brown & Williamson Tobacco Corp. v. Philip Morris Inc.*, 229 F.3d 1120, 1124-25, 56 USPQ2d 1456, 1459 (Fed. Cir. 2000) ("a showing of a suggestion, teaching, or motivation to combine the prior art references is an 'essential component of an obviousness holding'") (quoting *C.R. Bard, Inc., v. M3 Systems, Inc.*, 157 F.3d 1340, 1352, 48 USPQ2d 1225, 1232 (Fed. Cir. 1998)); *In re Dembiczak*, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999) ("Our case law makes clear that the best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references."); *In re Dance*, 160 F.3d 1339, 1343, 48 USPQ2d 1635, 1637 (Fed. Cir. 1998) (there must be some motivation, suggestion, or teaching of the desirability of making the specific combination that was made by the applicant); *In re Fine*, 837 F.2d 1071,

1075, 5 USPQ2d 1596, 1600 (Fed. Cir. 1988) ("'teachings of references

can be combined only if there is some suggestion or incentive to do so.'")

(emphasis in original) (quoting *ACS Hosp. Sys., Inc. v. Montefiore Hosp.,*

732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984)).

The need for specificity pervades this authority. See, e.g., *In re*

Kotzab, 217 F.3d 1365, 1371, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000)

("particular findings must be made as to the reason the skilled artisan, with

no knowledge of the claimed invention, would have selected these

components for combination in the manner claimed").

The Claims

Claim 1 recites a method of processing a multi-media editing

project comprising [emphasis added]:

- generating a request for one or more multi-media files for use in a multi-media editing project, the request being generated by a user computer that comprises part of a network where multi-media files are maintained in a network –accessible location;
- intercepting the request;
- ascertaining whether a requested multi-media file is located on the user computer by checking *one or more user-designated directories for the multi-media file,* wherein said one or more user-designated directories can be designated by a user specifying a path name for said one or more user-designated directories;
- retrieving the multi-media file if the file is located on the user computer; and
- seeking the requested file from the network-accessible location if the multi-media file is not located on the user computer.

In making out the rejection of this claim, the Office argues that Tso discloses the subject matter of this claim except for specifying a path name for one or more user-designated directories, citing to column 14, lines 11-56 for support. The Office then argues that modifying Tso to incorporate this feature would be obvious "because doing so would have the same functionality which is to determine the existence of the requested files on the client computer before retrieving the file from a remote network location."

Applicant respectfully submits that the Office has not established a *prima facie* case of obviousness for at least two reasons. First, Tso does not disclose what the Office says it does; and second, the Office's stated motivation to make the modification of Tso is lacking in particular findings which, as noted above, must be made as to the reason the skilled artisan, with no knowledge of the claimed subject matter, would have selected these components for combination in the manner claimed does

Addressing the first reason, the Office argues that Tso discloses the third recited element (i.e. ascertaining whether a requested multi-media file is located on the user computer by checking *one or more user-designated directories for the multi-media file*...), and cites to Tso's column 14, lines 21-36 for support. This excerpt, as well as the surrounding text, is reproduced below for the convenience of the Office. The specific excerpt cited by the Office is set off in bold italics.

> In this particular embodiment, HTTP local proxy 48 first checks whether the requested hypertext object exists in client-side cache memory 56 (Step 120). To do this, HTTP local proxy 48 may

invoke client-side parser 50 using a GetScaledObject(URL) call, which in turn issues a GetEntry call to client-side cache interface 54 to open a stream for the cached object. This effectively "retrieves" the cached object from client-side cache memory 56 if it exists (Step 140). HTTP local proxy 48 then passes the stream to browser 32, which displays the cached object to the user (Step 150).

Referring now to FIG. 8, if the requested URL object is not found in client-side cache memory 56, HTTP local proxy 48 transmits a request for the object to transcoding server 34 using, for example, a Post of a GetStage(URL, Stage=0) call (Step 160). Upon receipt of this call, HTTP remote proxy 36 invokes parser 22, which in turn issues a GetScaledObject a call to server-side cache interface 28 to determine whether a non-transcoded version of the requested hypertext object already exists in the server-side cache memory 30 (Step 170). If the hypertext object is cached, server-side cache interface 28 issues a GetEntry call to open a stream for the cached object (Step 200). In addition, parser 22 may issue a GetProperties(URL, . . .) call to server-side cache interface 28 to retrieve information about the transcoding properties and transcoded status (such as the refinement level) of the cached object.

If parser 22 determines that the requested hypertext object does not exist in the server-side cache memory 30, HTTP remote proxy 36 issues an HTTP request to retrieve the hypertext object from Internet 18 (Step 190). If the object is not found, HTTP remote proxy 36 returns an error to network client 12 which browser 32 will communicate to the user (Step 220); if the object is found, HTTP remote proxy 36 passes the handle for the incoming data stream to parser 22, which in turn initiates caching of an original version of the retrieved hypertext object (Step 230).

Referring now to FIG. 9, once the requested hypertext object has started to be obtained, parser 22 determines whether (and how) to transcode the object before transmitting it to network client 12 (Step 240). Both this decision-making process and exemplary transcoding processes are described in detail above. For purposes of the present illustration, assume parser 22 determined that transcoding was appropriate and therefore generated a transcoded version of the requested hypertext object (Step 250).

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This excerpt in no way discloses or suggests checking one or more *user-designated* directories. Accordingly, for at least this reason, Tso does not disclose all elements of the recited claim and hence, has not established a *prima facie* case of obviousness. As such, it is virtually impossible for Tso to disclose, suggest or even provide support for "specifying a path name for ... one or more user-designated directories".

Addressing the second reason (i.e. the Office's stated motivation to modify Tso so that it specifies a path name), there is no teaching or suggestion in Tso to support this modification. In addition, the Office's stated motivation – because doing so would have the same functionality – falls far short of providing particular findings as to the reason the skilled artisan, with no knowledge of the claimed subject matter, would have selected these components for combination in the manner claimed.

Accordingly, for any of these reasons, the Office has failed to establish a *prima facie* case of obviousness and this claim is allowable.

Claims 2-11 depend from claim 1 and are allowable as depending from an allowable base claim.

Claim 12 recites a method of processing a multi-media editing project comprising [emphasis added]:

- maintaining information on a local computer that comprises part of a network having multiple computers, said information being associated with multi-media files that are maintained in a network-accessible location and that can be temporarily stored on the local computer's hard drive; and
- responsive to a request to retrieve a multi-media file from the network-accessible location, using the information to attempt to locate the requested file on the local computer's hard drive

in *one or more user-designated directories before attempting* to retrieve the file in the network-accessible location, *wherein said one or more user-designated directories can be designated by a user specifying a path name for said one or more user-designated directories.*

In making out the rejection of this claim, the Office makes the same argument and uses the same reasoning as set forth above in the rejection of claim 1. For all of the reasons set forth above with regard to claim 1, the Office has failed to establish a *prima facie* case of obviousness. Accordingly, this claim is allowable.

Claims 13-18 depend from claim 12 and are allowable as depending from an allowable base claim.

Claim 19 recites one or more computer-readable media having computer-readable instructions thereon which, when executed by a computer, cause the computer to [emphasis added]:

- maintain a list on a local computer that comprises part of a network having multiple computers, said list being used to determine which local *user-designated directories have been used in the past, or are currently being used to stored multi-media files that are maintained in a network-accessible location, wherein said user-designated directories can be designated by a user specifying a path name for said user-designated directories*; and
- responsive to a request to retrieve a multi-media file from the network-accessible location, use the list to first attempt to locate the requested file on the local computer's hard drive.

In making out the rejection of this claim, the Office makes the same argument and uses the same reasoning as set forth above in the rejection of

claim 1. For all of the reasons set forth above with regard to claim 1, the Office has failed to establish a *prima facie* case of obviousness. Accordingly, this claim is allowable.

Claims 20-24 depend from claim 19 and are allowable as depending from an allowable base claim.

Claim 25 recites a method of processing a multi-media editing project comprising [emphasis added]:

- receiving one or more multi-media files from a network-accessible location;
- locally storing the one or more multi-media files in a local *user-designated directory* on a user computer for use in a multi-media editing project, *wherein said user-designated directory can be designated by a user specifying a path name for said user-designated directory*;
- updating a list of local user-designated directories that contain or have contained multi-media files in the past in the event that the one or more multi-media files are stored in a local user-designated directory that is not contained in the list;
- responsive to receiving a request for a multi-media file that is maintained in the network-accessible location:
- first checking in all of the local user-designated directories on the list of local user-designated directories for the requested file; and
- second checking the network-accessible location for the requested file in the event the requested file is not found locally.

In making out the rejection of this claim, the Office makes the same argument and uses the same reasoning as set forth above in the rejection of claim 1. For all of the reasons set forth above with regard to claim 1, the

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Office has failed to establish a *prima facie* case of obviousness. Accordingly, this claim is allowable.

Claims 26-29 depend from claim 25 and are allowable as depending from an allowable base claim.

Claim 30 recites one or more computer-readable media having computer-readable instructions thereon which, when executed by a computer, cause the computer to [emphasis added]:

- maintain a list of local *user-designated directories* that are or have been used to store multi-media files on a local user computer, the multi-media files being accessible from a network storage location, *wherein said user-designated directories can be designated by a user specifying a path name for said user-designated directories*;
- generate a request for a multi-media file that is accessible from a network storage location, the request being intended for use in retrieving a multi-media file from the network accessible storage location;
- intercept the request;
- ascertain a requested file from the request;
- first, determine whether the requested file is locally available by checking all of the local user-designated directories maintained on the list and retrieve the requested file from a local user-designated directory if the file is locally maintained;
- second, seek the requested file from the network storage location if the file is not locally maintained;
- store the requested file in a local user-designated directory if the requested file is retrieved from the network storage location; and
- update the list to reflect the local user-designated directory if the local user-designated directory in which the requested file is stored is not on the list.

In making out the rejection of this claim, the Office makes the same argument and uses the same reasoning as set forth above in the rejection of claim 1. For all of the reasons set forth above with regard to claim 1, the Office has failed to establish a *prima facie* case of obviousness. Accordingly, this claim is allowable.

Claim 31 depends from claim 30 and is allowable as depending from an allowable base claim.

Claim 32 recites a multi-media editing system comprising [emphasis added]:

- a multi-media file locator object configured to intercept network-bound requests for multi-media files and determine whether requested files are locally maintained on a user computer in one or more *user-designated directories, wherein said one or more user-designated directories can be designated by a user specifying a path name for said one or more user-designated directories*; and
- a list associated with the file locator object and referencing local *user-designated file directories* on the user computer where multi-media files are stored, the list being used by the file locator object to determine whether requested files are locally maintained on the user computer.

In making out the rejection of this claim, the Office makes the same argument and uses the same reasoning as set forth above in the rejection of claim 1. For all of the reasons set forth above with regard to claim 1, the Office has failed to establish a *prima facie* case of obviousness. Accordingly, this claim is allowable.

Claims 33-39 depend from claim 32 and are allowable as depending from an allowable base claim.

Conclusion

All of the claims are in condition for allowance. Accordingly, Applicant requests a Notice of Allowability be issued forthwith. If the Office's next anticipated action is to be anything other than issuance of a Notice of Allowability, Applicant respectfully requests a telephone call for the purpose of discussing an appeal in this case.

Respectfully submitted,

Dated: May 10, 2005   By: _____

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